THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY R. PRYOR

Appeal No. 1997-2981
Application 08/161,304[1]

ON BRIEF

Before KRASS, FLEMING, and FRAHM, Administrative Patent Judges.

---

[1]Application for patent filed December 2, 1993. According to appellant, this application is a continuation of Application 07/848,937, filed March 10, 1992, now abandoned; which is a continuation of Application 07/509,295, filed April 16, 1990, now U.S. Patent No. 5,112,131; which is a continuation of Application 07/042,527, filed April 27, 1987, now U.S. Patent No. 5,012,574; which is a continuation of Application 06/767,374, filed August 20, 1985, now abandoned; which is a continuation of Application 06/560,259, filed December 12, 1983, now U.S. Patent No. 4,559,684; which is a continuation of Application 03/238,702, filed February 21, 1981, now abandoned.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 39 and 41 through 50, all of the claims pending in the application.

The invention pertains to manufacturing methods for producing an object with a desired contour, for shaping manufactured parts and for assembly of parts.

Representative independent claim 39, directed to producing an object with a desired contour, is reproduced as follows:

39. A method of producing an object with a desired contour, comprising the steps of:

a) rapidly, accurately, and on-line, electro-optically determining the existing contour of said object;

b) providing, on a surface of said object, a marking containing information related to said existing contour as determined in step a); and

c) utilizing said information contained in said marking to control the production of said object.

The examiner relies on the following references:

Idelsohn et al. (Idelsohn)	4,149,089	Apr. 10, 1979
Pryor et al. (Pryor)	4,373,804	Feb. 15, 1983

Claims 39 and 41 through 50 stand rejected as alternatively anticipated under 35 U.S.C. 102(b) by Idelsohn or under 35 U.S.C. § 102(e) by Pryor.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation.

Nevertheless, we will sustain the rejection of claim 39 and its dependent claim 46 under both 35 U.S.C. § 102(b) and § 102(e). However, we will not sustain the rejections of claims 41 through 45 and 47 through 50 under either 35 U.S.C. § 102(b) or § 102(e).

Turning first to the rejection of claim 39 under 35 U.S.C.

§ 102(b), while we certainly understand the difference between the instant *disclosed* invention and that taught by Idelsohn, it is our view that the language of instant claim 39 is of such broad nature as to read on Idelsohn. Idelsohn clearly discloses a method for producing an object (a cut board or boards) with a desired contour (i.e., the shape of the board) by "rapidly, accurately, and on-line, electro-optically determining the existing contour of said object" (Idelsohn uses an optical scanner for "rapid and accurate [column 4, lines 4-5] determination of the defects, their type and location," i.e., the "existing contour" of the object is determined). Then, a "mark" is provided on the surface of the object [column 3, line 60] and this mark contains "information related to said existing contour as determined in step a)." That is, the mark contains information as to where a cut should be made and the position of the cut is clearly "related to said existing contour" in the sense that the size and shape of the board will determine where the cut or cuts should be made for optimum use of the board. Finally, Idelsohn utilizes the information contained in the marking, i.e., the mark used for cutting, "to control the production of said object." That

is, using the mark in Idelsohn, the cut or cuts are made and the cut pieces of lumber constitute the "production of said object."

Appellant's arguments regarding scanning the mark, the mark being simply the output of a computer after determination of a proper cutting location and the mark not actually containing any information are unpersuasive. Claim 39 does not preclude the "marking" from being the output of a computer, nor does the claim require the marking to be scanned. With regard to containing information, as explained supra, the mark in Idelsohn certainly does "contain information" as to where the cut or cuts should be made in order to produce the object. In accordance with the broad claim language, it does not matter that it is the position of the mark in Idelsohn which offers this information rather than a bar code, as envisioned by appellant.

Turning now to the rejection of claims 39 and 46 under 35 U.S.C. § 102(e), it is our view that Pryor also anticipates the instant claimed invention, as broadly set forth.

Appellant does not dispute that Pryor discloses a method for electro-optically determining the dimension of part

surfaces nor that Pryor discloses the use of bar codes and orientation codes to assist a robot in picking up or maneuvering a part properly. However, appellant argues that Pryor does not disclose attaching any code to the part which contains information related to the determined contour of the part. We disagree. If Pryor identifies a part, which it clearly must for the robot to know what part is being maneuvered, then since a given part has a given contour, it can be reasonably stated that the contour of that part is known. While the computer program in the robot need not identify which part is which [column 13, lines 33-34], the bar code part type is indicative of the part and, hence, its contour. Thus, the marking contains information, even if only implicitly, related to the existing contour of the object.

Appellant argues that Pryor discloses the placement of a bar code or orientation code on the part surface "before" any action is taken with respect to the part. Even if true, it is not clear how this is precluded by the instant claim language.

With regard to dependent claim 46, this claim merely requires the contour to be "three dimensional." Since the parts in Pryor and the lumber in Idelsohn are clearly three

dimensional objects, this claim limitation is met.

With regard to claims 41-45 and 47-50, we will not sustain the rejection of these claims under 35 U.S.C. § 102.

Each of these claims requires, in one form or another, "a further shaped part" or "interaction" of first and second parts in some manner. Idelsohn is concerned with only one "part," viz, a board to be cut. Pryor is concerned with one part at a time and that part is not used in any manner to manufacture a "further shaped part." Neither reference is concerned with any interaction between first and second parts.

Moreover, the examiner never comes to grips with these specific claim limitations. They are not addressed in the statement of the rejection of these claims and they are not addressed in the response to appellant's arguments section of the answer. The only response that comes close to addressing these claim limitations appears at page 4 of the answer where the examiner talks about the marks on the lumber in Idelsohn containing information and that this accumulated "...information which describes a piece of lumber is used to select a <u>further</u> object or piece of lumber for future production." The examiner then goes on to contend that

certain practices are known in the lumber industry. However, we find no suggestion in either Idelsohn or Pryor for providing a "further shaped part" from the utilization of the determined contour of the first shaped part, as claimed. The examiner has failed to particularly point out how each and every claimed element is met by the applied references.

We have sustained the rejection of claims 39 and 46 under both 35 U.S.C. § 102(b) and § 102(e) but we have not sustained the rejection of claims 41 through 45 and 47 through 50 under either 35 U.S.C. § 102(b) or § 102(e). Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Errol A. Krass Administrative Patent Judge	)	
Michael R. Fleming Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Eric Frahm Administrative Patent Judge	)	

tdl

LARSON & TAYLOR
Transpotomac Plaza
1199 North Fairfax St., Suite 900
Alexandria, VA 22314